



PATENT

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ON 4 MAY 2006

Lisa L. Pringle
SIGNATURE LISA L. PRINGLE

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kenneth Aull
Serial No. : 09/823,701
Filing Date : March 30, 2001
For : PREVENTING ID SPOOFING WITH
UBIQUITOUS SIGNATURE
CERTIFICATES
Group Art Unit : 2137
Examiner : Kevin R. Schubert
Attorney Docket No. : NG(MS)7185
Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Advisory Action filed in this case on April 10, 2006, please enter and consider the following remarks

Remarks/Arguments begin on page 2 of this paper.

REMARKS

Claims 1-16 are currently pending in the subject application, and are presently under consideration. Claims 1-16 are rejected. Favorable reconsideration of the application is requested in view of the comments herein.

I. The Rejection of Claims 1 and 9 Under 35 U.S.C. §103(a) Was Made in Error

Claims 1 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,878,138 to Yacobi ("Yacobi") in view of the following URL:
http://web.archive.org/web/20000303141313/www.txdps.state.tx.us/administration/driver_licensing_control/faq.htm, for the Texas Department of Public Safety ("Texas DPS") in the Final Office Action dated February 16, 2006 ("Final Rejection"). It is respectfully submitted that this rejection was made in error.

Claims 1 and 9 recite a method and an apparatus, respectively, for preventing ID spoofing in a public key infrastructure (PKI), that maintains a one-to-one correspondence between users of an enterprise and signature certificates. Neither Yacobi nor Texas DPS teaches or suggests that a registration server informs a user that a new signature certificate will not be issued until the old signature certificate has been revoked, as recited in claims 1 and 9. In the Response to the Final Office Action of March 26, 2006, ("Final Response"), on pages 2-3, Applicant clearly sets forth as to why Yacobi taken in view of Texas DPS fails to meet this element of claims 1 and 9. Specifically, the section of Texas DPS cited in the Final Rejection discloses that in order for a person to get a Texas driver's license, that person will be required to surrender his/her valid or expired Out-of-State driver's license (See Texas DPS, Page 1). Texas DPS is devoid of any process or structure that could be construed as a signature certificate recited in claims 1 and 9. Thus, Texas DPS cannot teach or suggest a registration server informs a user that a new signature certificate will not be issued until the old signature certificate has been revoked, as recited in claims 1 and 9. Accordingly, neither Yacobi nor Texas DPS, taken individually or in combination, teach or suggest each and every element of claims 1 and 9.

Additionally, in the Final Response, Applicant clearly set forth reasons as to why one skilled in the art would not look to combine and modify the teachings of Yacobi and Texas DPS in the manner suggested by the Office Action (See Final Response, Pages 3-4). Specifically, combining and modifying Yacobi and Texas DPS for the reasons given by the Examiner in the Office Action would change the principle of operation of Yacobi. Yacobi discloses electronic wallets that can be used at ATM machines and to purchase tokens on a public transportation system (See Yacobi, Col. 4, Lines 28-43). Clearly, the electronic wallets disclosed in Yacobi are designed to be used by laypersons. Therefore, including informing a user that a new signature certificate will not be issued until the old signature certificate has been revoked, as recited in claim 1, would add unneeded and unwanted complexity to the renewal process disclosed in Yacobi. Thus, there is no motivation to combine and modify the teachings of Yacobi and Texas DPS in the manner suggested by the Office Action.

Further still, Applicant clearly set forth reason that Texas DPS is not analogous art to claims 1 and 9 (See Final Response, Pages 4-5 (claim 1) and Page 6 (claim 9)). Specifically, Texas DPS is not in the same field of endeavor as claims 1 and 9 and Texas DPS is not reasonably pertinent to the problem being solved by claims 1 and 9. For the reasons stated in the Final Response, Texas DPS and claim 1 and 9 are clearly not in the same field of endeavor, because Texas DPS is related to driver's license administration, while claims 1 and 9 are related to PKI certificates. Accordingly, Texas DPS is not in the same field of endeavor for the reasons stated in the Final Response.

In the Advisory Action issued on April 10, 2006 ("Advisory Action"), the Examiner contends that the reasons given in the Final Response that Texas DPS was not reasonably pertinent to claim 1 was not persuasive. Applicant respectfully disagrees. In *In re Clay*, the Court of Appeals for the Federal Circuit ("Federal Circuit") set forth a test to determine if a reference was reasonably pertinent to the problem being solved. 966 F.2d 658, 23 U.S.P.Q.2d 1058, 1060-1061 (Fed. Cir. 1992). In *In re Clay*, the Federal Circuit held that a reference is reasonably pertinent if it is a reference, because of the matter with which it deals, logically would have commended itself to the inventors attention in considering his problem. 966 F.2d 658, 23

U.S.P.Q.2d 1058, 1061. In *In re Clay*, the Federal Circuit held that a reference which disclosed gel treatment of underground formations functions to fill anomalies was not reasonably pertinent to a gel function to displace liquid product from dead volume of a storage tank. 966 F.2d 658, 23 U.S.P.Q.2d 1058, 1061. It is respectfully submitted that the present case is analogous to *In re Clay*, in that one skilled in the art of PKI certificates would not look to a driver's license administration procedure (Texas DPS) to implement the subject matter recited in claims 1 and 9.

The Examiner argues that Texas DPS is reasonably pertinent because it addresses identity spoofing (See Advisory Action, Page 2). However, Texas DPS relates to a relatively insecure administration of driver's licenses. In fact, Texas DPS discloses that if a person loses his/her driver's license, that person can obtain a new one (See Texas DPS, page 1). Claims 1 and 9 relates to administration of signature certificates in a high security PKI. Thus, Texas DPS would not have commended itself to one of ordinary skill in the art since Texas DPS operates in a completely different fashion than claims 1 and 9. Therefore, Texas DPS is not reasonably pertinent to the problem being solved by claims 1 and 9. Accordingly, Texas DPS is not analogous art to claims 1 and 9.

For the reasons stated above, it is respectfully submitted that the rejection of claims 1 and 9 was made in error. Accordingly, allowance of claims 1 and 9, as well as all claims depending therefrom, is respectfully requested.

I. The Rejection of Claims 5 and 13 Under 35 U.S.C. §103(a) Was Made in Error

Claims 5 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yacobi in view of U.S. Patent No. 6,308,277 to Vaeth ("Vaeth"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Applicant respectfully submits that the Examiner erred in finding that Yacobi, taken in view of Vaeth, teaches or suggest each and every element of claims 5 and 13. In the Final Response, Applicant argued when claims 5 and 13 are read as a whole, it is clear that the user recited does not possess a valid signature certificate, and the user is requesting a new user signature certificate (See Final Response, Pages 6-7). For the reasons stated in the Final

Response, in Yacobi, any user that possess an electronic wallet also possesses a certificate (See Final Response, Page 7). Thus, Yacobi taken in view of Vaeth does not teach or suggest allowing a user to access a registration server, as recited in claims 5 and 13.

Additionally, it is respectfully submitted that the Examiner erred in finding motivation to combine and modify the teachings of Yacobi and Vaeth. Applicant set forth reasons as that one of ordinary skill in the art would not look to combine and modify the teachings of Yacobi and Vaeth in the manner suggested by the Examiner in the Final Response (See Final Response, Page 8 (Claim 5) and Page 10 (Claim 13)). Specifically, Yacobi presupposes any user that requests a new certificate is already in possession of a current certificate. Since Yacobi requires that any user that requests a new certificate be in possession of a current certificate, any bank computer receiving the request for the new certificate would receive the current certificate, which would be in the bank computer's database. Accordingly, in Yacobi, there would not be a time when a user requesting a new certificate would not be in possession of a certificate that was not in the bank computer's database. Thus, there would be no need to include the step of upon a registration server receiving information from a directory indication that an identified user is not in a directory the registration server informing the user that the user is not a valid member of the enterprise and not issue a signature certificate, as recited in claims 5 and 13 in Yacobi.

Furthermore, in the Final Rejection, the Examiner contends that combining Yacobi and Vaeth would not tradeoff of security for convenience (See Final Rejection, page 9). Applicant respectfully disagrees for the reasons stated in the Final Response (See Final Response, Pages 8-9). Specifically, Applicant submits that in Vaeth a requestor using an Internet browser can request a certificate using a certificate web page. In contrast, Vaeth requires that a user be in possession of a special piece of hardware, namely an electronic wallet in order to request a certificate. The combination of Yacobi and Vaeth would be a less secure system because certificates and private keys can easily be copied off personal computers that include Internet browsers (e.g., by computer viruses, hackers, etc.).

As stated in the Final Response, the Federal Circuit has held that one of ordinary skill in the art would not have reasonably elected trading the benefit of security for that of convenience.

Winner Int'l Royalty Corp. v. Ching-Rong Wang, 202 F.3d 1340, 1349, 53 U.S.P.Q.2d 1587 (Fed. Cir. 2000). It is respectfully submitted that to combine and modify the teachings of Yacobi and Vaeth in the manner suggested by the Examiner would result in a less secure system. Accordingly, it would not have been obvious to one of ordinary skill in the art to combine and modify the teachings of Yacobi and Vaeth in the manner suggested by the Examiner.

For the reasons stated above, it is respectfully submitted that the rejection of claims 5 and 13 was made in error. Accordingly, allowance of claims 5 and 13, as well as all claims depending therefrom, is respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

Please charge any deficiency or credit any overpayment in the fees for this Appeal Brief to Deposit Account No. 20-0090.

Respectfully submitted,



Christopher P. Harris
Reg. No. 43,660

TAROLLI, SUNDHEIM, COVELL
& TUMMINO, L.L.P.
1300 East Ninth Street, Suite 1700
Cleveland, Ohio 44114
(216) 621-2234
(216) 621-4072 (Facsimile)
Customer No.: 26294